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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/572,940

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Takashi Mitsui

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WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

OSELE, MARK A

ART UNIT

PAPER NUMBER

1745

NOTIFICATION DATE

DELIVERY MODE

11/23/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentmail@whda.com

Office Action Summary	Application No. 10/572,940	Applicant(s) MITSUI ET AL.	
	Examiner MARK A. OSELE	Art Unit 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-32 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-9, 11, 14, 15, 21, 22, 25, 26 and 29-32 is/are rejected.
- 8) ☒ Claim(s) 10, 12, 13, 16-20, 23, 24, 27 and 28 is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8, 11, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Maeda ((U.S. Patent # 6,796,351). Maeda shows a transfer tool that used for transferring a transfer material, A, on a transferred object, 20, such as paper, comprising: a transfer tool main body, 10, having a transfer head, 12, that can bring at least the transfer material, A, into contact with the transferred object, 20; and a transferred object receiver, 26, 27, that is accompanied by the transfer tool main body; wherein a transfer head has a transfer face, 15, that is a region contacting the transferred object and transferring the transfer material when transferring the transfer material on the transferred object; an insertion space is formed between the transfer tool main body and the transferred object receiver, in which the transferred object, 20, can be inserted; the transfer head is positioned so that at least the transfer face is exposed in the insertion space (See Figs. 2-3); and the transfer material is transferred on the transferred object by slidably moving the transfer face to a predetermined transfer direction, F (See Fig. 5) while bringing the transfer face into contact with the transferred object with the transferred object inserted in the insertion space and the

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transferred object sandwiched between the transfer tool main body and the transferred object receiver.

Regarding claim 2, the insertion space is continuously opened to three directions comprising a transfer direction, F, a reverse transfer direction, and a direction orthogonal to the transfer direction and the reverse transfer direction.

Regarding claim 3, the transfer material is transferred on the transferred object by sliding the transfer face of the transfer head on the surface of the transferred object upon transfer (column 8, lines 4-22, 34-58).

Regarding claim, 4, the transfer head comprises a transfer roller, 15, having the transfer face that can be rotated upon transfer.

Regarding claim 5, the transfer tool has a first auxiliary roller, 26, provided on the transferred object receiver, which can be rotated in conjunction with the transfer roller upon transfer.

Regarding claims 6-7, the first auxiliary roller has a backing face that is a region that can be opposed to the transfer face and can contact the rear face of the transferred object upon transfer and the backing face and the transfer face are relatively connected and separated from each other (See Fig. 2).

Regarding claim 8, the transferred object receiver comprises a base, 23 (first portion) and at least the first auxiliary roller, and further comprises an arm portion, 23 (orthogonal portion), that can carry out the balancing operation with respect to the base.

Regarding claim 11, the transfer tool comprises a pair of second auxiliary rollers, 26, which are opposed at the side of the transfer tool main body and the side of the

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transferred object at a position in the insertion space that is different from the position where the transfer roller is opposed to the first auxiliary roller (See Fig. 4).

Regarding claim 14, the transferred object receiver comprises a base, 23 (first portion) and at least one second auxiliary roller, and further comprises an arm portion, 23 (orthogonal portion), that can carry out the balancing operation with respect to the base.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 9, 15, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maeda ((U.S. Patent # 6,796,351) in view of Shinozaki et al. (U.S. Patent # 6,698,489). As shown in paragraph 2 above, Maeda shows the claimed limitations but fails to show the first auxiliary roller to be deformed in a direction from the transfer head. Shinozaki et al. also shows a transfer tool wherein a first auxiliary roller cradle, 3, supporting a rotational support shaft of the first auxiliary roller, 7, so it can be elastically deformed in a direction connecting and separating to and from the transfer head, 6, to allow the tool to be placed around a transferred object (column 5, lines 46-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to make

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the base of Maeda elastically deformable as shown by Shinozaki et al. in order to allow for easy insertion of the transferred object into the transfer tool.

Regarding claim 15, Shinozaki et al. further shows the auxiliary roller cradle to be elastically deformed in relation to second auxiliary rollers, 5.

Regarding claim 21, Shinozaki et al. shows regulating means that prevents the transfer tool main body and transferred object receiver from moving beyond a certain set point (See Figs. 2-3).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 8, 15, 21-22, 25-27, and 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15, line 2 includes the limitation “the other second auxiliary roller” in line 5. It is unclear which other second auxiliary roller is being referred to as there is another secondary roller in the pair of secondary auxiliary rollers or any number of auxiliary rollers in the additional pairs of auxiliary rollers as proposed by claim 11. One solution would be to insert the phrase, ‘of the pair of second auxiliary rollers’ after “roller” in line .

Claim 21 recites, “from moving within a predetermined distance or more from one another,” which is not idiomatic English and is therefore unclear. This seems to suggest

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that the two parts cannot move closer than a preset spacing or farther than that same preset spacing. These two prohibitions are contradictory.

Claim 22, line 4, “abuts against the other one by priority” is not idiomatic English.

Claim 25 recites, “from moving within a predetermined distance or more from one another,” which is not idiomatic English and is therefore unclear. This seems to suggest that the two parts cannot move closer than a preset spacing or farther than that same preset spacing. These two prohibitions are contradictory.

Claim 26, line 4, “abuts against the other one by priority” is not idiomatic English.

Claim Objections

7. Claim 1 is objected to because of the following informalities: line 1, after “that”, ‘is’ should be inserted; line 14, “to” should be deleted and ‘is’ inserted therein. Claim 28 is objected to because of the following informalities: line 19, the first occurrence of “a” should be deleted and ‘an’ inserted therein. Appropriate correction is required.

Allowable Subject Matter

8. Claims 10, 12-13, 16-20, 23-24, and 27-28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. Claims 22, 25-26, and 29-32 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art transfer tools show the limitations of the allowable claims such as: endless track mechanisms winding a crawler track; the transferred object receiver covering the transfer head in one position but not in another position of the transferred object receiver; and an elongated chip regulating means.

Response to Arguments

11. Applicant's arguments filed September 23, 2011 have been fully considered but they are not persuasive. Applicants argue that the amendment to claim 1 incorporates the limitations of allowable claim 10, but the only amendment to claim 1 was deletion of "a" in line 6 and insertion of "the" therein. As the amended claims have the same limitations as the originally filed claims, the prior art rejections remain pertinent.

As to the claim amendments to overcome the 35 USC § 112 second paragraph, those rejections that have been overcome have been rescinded while the rejections on the remaining claims have been further clarified in the rejection above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

12. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARK A. OSELE whose telephone number is (571)272-1235. The examiner can normally be reached on M-F 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Philip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARK A OSELE/
Primary Examiner, Art Unit 1745
November 17, 2011